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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/604,975

08/29/2003

Hideki Nishimura

18.008-C

1974

29453

7590

09/10/2004

EXAMINER

JONES, JUDSON

JUDGE PATENT FIRM

RIVIERE SHUKUGAWA 3RD FL.

3-1 WAKAMATSU-CHO

NISHINOMIYA-SHI, HYOGO, 662-0035

JAPAN

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/604,975	NISHIMURA ET AL.	
	Examiner	Art Unit	
	Judson H. Jones	2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13-22 and 30-34 is/are rejected.
- 7) ☒ Claim(s) 6-12 and 23-29 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1, 6, 16, 18, 23 and 33 are objected to because of the following informalities: In claims 1 and 18 the phrase "said bearing section" in the last line is indefinite. Applicant mentions a radial bearing section, a thrust bearing section and an axial support section. Applicant needs to clarify which bearing section is meant. Also in claim 6 line 39, in claim 16 line 21, in claim 23 line 44 and in claim 33 line 21 the phrase "said bearing section" is unclear. Appropriate correction is required.

Claims 2, 17 and 34 are objected to because of the following informalities: Both claims include the phrase "according as its separation from said rotor top plate." The phrase is grammatically incorrect, making the meaning unclear. Appropriate correction is required.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and

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useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-5 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5 of copending Application No. 10/063,929. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. While the words of the claims are not identical because the claims in the '929 application have been amended because of objections based on lack of clarity of the claim language, the claims are drawn to identical subject matter.

Claims 13-17 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11-15 of copending Application No. 10/063,929. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 18-22 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 16-20 of copending Application No. 10/063,929. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 30-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26-30 of co-pending Applicant No. 10/063,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 30 of the instant application is the same as claim 36 of the '929 application except for the deletion of the cover member, micro-gaps and continuously retained oil elements of the '929 application. Since elimination of an element and its functions is not viewed as a patentable advance, the instant claims are not patentable over claims 26-30 of the co-pending patent. See *In re Karlson*, 136 USPQ 184 (CCPA 1963).

Allowable Subject Matter

Claims 6 and 23 and their dependent claims 7-12 and 24-29 would be allowable if rewritten or amended to overcome the objections to the claims as set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose or teach a spindle motor with radial and thrust bearing sections with a communicating passageway formed between the shaft and casing member and with an axial support section formed between the cover member inner face and a shaft end face in combination with the other features of claims 6 and 23.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanaka et al. 6,712,513 B2 discloses a spindle motor with radial and thrust bearing sections with a communicating passageway but does not disclose a cover member closing over

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one end of the through hole formed in the sleeve as recited in claims 1, 6 and 23 and does not disclose an axial support section between a top plate bottom and a sleeve upper-end face as recited in claims 1, 6, 13, 18, 23 and 30. Ishikawa et al. 6,702,466 B2 discloses an axial thrust bearing on the top portion and bottom portion of a spindle motor device combined with a radial bearing. Yoshikawa et al. 6,71,310 B2 discloses a cover plate closing one end of the through hole of a sleeve but does not disclose an axial support between a top plate bottom and a sleeve upper end face. No reason has been found for combining the teaching of Ishikawa in regard to top and bottom axial support means with either Tanaka et al. or Yoshikawa et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judson H. Jones whose telephone number is 571-272-2025. The examiner can normally be reached on 8-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 571-272-2044. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JHJ 9/7/2004



THANH LAM
PRIMARY EXAMINER